

REMARKS

Applicant thanks the examiner for the review of the long and extensive file history in the present matter. Claim 24 has been cancelled. Claims 1-20 and 25 remain pending. No new matter has been added. Claims 1-20 and 25 are in condition for allowance.

Assignee Consent

The examiner is requiring that Applicant provide Assignee's written consent to the reissue. Applicant respectfully traverses the requirement.

Assignee provided its consent in a filing dated July 1, 1996. The consent was provided without establishing the Assignee's ownership interest in accordance with 37 CFR 3.73(b). Appendix I contains a copy of Assignee's original consent in compliance with MPEP 1410.01(I), and as required by 37 CFR 1.172(a). A Statement under 37 CFR 3.73(b) is included, as filed in the present application on January 25, 2001, along with a copy of the assignment and its Notice of Recordation, to establish Assignee's ownership interest at the time the original Assignee Consent was signed. Applicant is also providing an updated Consent of Assignee, Form PTO/SB/53, and an updated Statement under 37 CFR 3.73(b) to expedite prosecution.

Reissue Declarations

Claims 1-20 and 25 stand rejected for an allegedly defective reissue declaration under 35 U.S.C. 251. Applicant respectfully traverses the rejection. Appendix II contains copies of the original reissue declaration signed July 5, 1996, and the supplemental reissue declaration of April 28, 2003, for the examiner's convenience.

The reissue declaration as originally filed was proper. MPEP 1410.01 states that where the reissue application does not seek to enlarge the scope of any of the claims of the original patent, the reissue oath may be made and sworn to, or declaration made, by the assignee of the entire interest. MPEP 1414(II)(B) further states that Applicant need only specify one of the errors upon which reissue is based.

The original reissue declaration was signed by the assignee because the reissue application did not seek to enlarge the scope of any of the claims of the original patent. The

error upon which the reissue application was based was stated on page 2 of the Declaration as

"U.S. Patent No. 5,408,832 is wholly or partially inoperative or invalid by reason of a claim for foreign priority under 35 U.S.C. § 119 not having been perfected in the manner required by statute. The incident application claims priority under 35 U.S. C. §119 based on applicant's Italian Application M192 A 1416, filed June 8, 1992. A review of the file wrapper indicates that the conditions for meeting the claim for priority under 35 U.S.C. § 119 nevertheless were not met because the certified copy of applicants' Italian patent application was not filed with the Office."

As stated in MPEP § 1402, citing *Brenner v. State of Israel*, 158 USPQ 584 (D.C. Cir. 1968), failure to perfect priority is proper grounds for reissue. The reissue application, as-filed, did not seek to enlarge the scope of any of the claims. As such, the original reissue declaration was proper.

The supplemental declaration of April 28, 2003, was also proper. MPEP 1414.01 states that a supplemental declaration must be filed where any error under 35 U.S.C. §251 has been corrected and the error was not identified in the original reissue declaration. However, MPEP 1414.01(l) also makes it clear that

...there is no need to state an error which is relied upon to support the reissue application if:

- (A) an error to support a reissue has been previously and properly stated in a reissue oath/declaration in the application; and*
- (B) that error is still being corrected in the reissue application.*

If applicant chooses to state any further error at this point (even though such is not needed), the examiner should not review the statement of the further error.

The supplemental reissue oath/declaration must state an error which is relied upon to support the reissue application only where one of the following is true:

- (A) The prior reissue oath/declaration failed to state an error;*
- (B) The prior reissue oath/declaration attempted to state an error but did not do so properly; or*
- (C) All errors under 35 U.S.C. 251 stated in the prior reissue oath(s)/declaration(s) are no longer being corrected in the reissue application.*

MPEP 1414.01 further states that a supplemental declaration only needs to state that every error which was corrected in the reissue application not covered by the prior oath(s)/declaration(s) submitted in the application arose without any deceptive intention on the part of the applicant. Since a statement comparable to this is all that is required, the patent office provides a simple form for supplemental declarations. See PTO/SB/51/S.

The supplemental declaration of April 28, 2003, makes the required statement on page 2, stating

"All errors corrected in this reissue application arose without any deceptive intention on the part of the applicant."

Since the statement indicates all errors, the statement includes every error which was corrected in the reissue application not covered by the prior declaration. The statement is signed by all of the inventors and no corrections have been made that would require an additional supplemental declaration, meaning no additional corrections have been made after April 28, 2003. As such, the supplemental reissue declaration is a proper declaration and meets any need for a supplemental declaration in this reissue application.

Accordingly, and for at least the above reasons, Applicant respectfully requests withdrawal of the rejection of claims 1-20, and 25.

Recapture

Claims 1-20 and 25 stand rejected under 35 U.S.C. 251 as allegedly improperly attempting to recapture subject matter. Applicant respectfully traverses the rejection.

Claims 1-20 are merely reciting what was allowed in U.S. Patent No. 5,408,832, and no more. Claim 25 recites a process. The limitations at issue were never imposed on the process claims issued in U.S. Patent No. 5,408,832, as can be seen by referring to issued claims 1-16. As such, Applicant is not "seeking to omit the same limitations added in the parent patent" in new claim 25. Accordingly, Applicant respectfully requests that the rejection be withdrawn from claims 1-20, and 25.

Conclusion

Applicant respectfully submits that all requirements have been met and requests allowance of claims 1-20, and 25.

The Commissioner is hereby authorized to credit any overpayment, or charge any deficiencies, to TIPS Group PC Deposit Account No. 50-3539. Should the examiner believe that a telephone conference would be helpful, the examiner is invited to contact the undersigned at the telephone number set out below.

Respectfully submitted,

TIPS Group

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Brian S. Boyer
Brian S. Boyer, Ph.D.
Reg. 52,643

Correspondence Address:

TIPS Group
Customer No. 45,965
Tel.: 650-293-3365